

REMARKS

By this Reply, no claims have been amended. Accordingly, claims 1, 2, 6-27, 31-50, 52-65, and 87-94 remain pending in this application. Claims 1, 26, 50, and 91 are the sole independent claims.

On page 3 of the Office Action, claims 1, 2, 12, 15, 17, 20-27, 36-39, 41, and 44-49¹ were rejected under 35 U.S.C § 103(a) as being obvious over International Publication No. WO 01/30242 A1 to Paternuosto ("Paternuosto") in view of U.S. Patent No. 4,763,669 to Jaeger ("Jaeger") and in further view of U.S. Patent No. 1,609,014 to Dowd ("Dowd"). Applicants respectfully traverse this rejection.

No combination of Paternuosto, Jaeger, and Dowd discloses or suggests the claimed invention. For example, independent claim 1 discloses an end effector assembly for obtaining multiple tissue samples comprising, among other things, "wherein the holder is configured to receive both the cutting portion and the storage portion, wherein the holder has a groove for receiving both a protrusion on the cutting portion and a protrusion on the storage portion." Independent claim 26 discloses similar recitations. No combination of Paternuosto, Jaeger, and Dowd discloses or suggests at least this aspect of the claimed invention either alone or in combination with other aspects of each of respective claims 1 and 26.

¹ The bold heading on page 3 of the Office Action indicates that "[c]laims 1, 2, 12, 15, 17, and 20-27, 36 are rejected under 35 U.S.C 103(a) as being obvious over Paternuosto (WO 01/30242 A1) in view of Jaeger (US 4,763,669) and in further view of Dowd (US Patent 1,609,014)." But in view of the paragraph under that heading, Applicants understand that the Examiner intended to refer to claims 1, 2, 12, 15, 17, 20-27, 36-39, 41, and 44-49. Applicants request clarification if our understanding is incorrect.

Page 3 of the Office Action alleges that front rim 12 of Paternuosto corresponds to the claimed "cutting portion," half-shell 10b corresponds to the claimed "holder," and container element 22 corresponds to the claimed "storage portion." Even if Paternuosto teaches what the Office Action alleges, which Applicants do not necessarily concede, Paternuosto fails to disclose, teach, or otherwise suggest that "the holder is configured to receive both the cutting portion and the storage portion, wherein the holder has a groove for receiving both a protrusion on the cutting portion and a protrusion on the storage portion," as required by independent claims 1 and 26.

With respect to Paternuosto, page 3 of the Office Action states, "[t]he examiner contends that the holder portion is configured to receive the cutting portion because it is integral therewith and since it does receive it, or is attached to it, it therefore is configured to receive it. The claim is not limited to some means to receive it." Applicants respectfully disagree. The plain language of independent claims 1 and 26 includes structure to receive the cutting portion. Specifically, the holder includes a groove that receives a protrusion of the cutting portion. Even assuming that the hole in base wall 14 of half-shell 10b, as shown in Fig. 9 of Paternuosto, includes the claimed "groove" and that the alleged groove receives a rim on storage container 22, no portion of front rim 12 is received by the alleged groove. Accordingly, Paternuosto does not disclose or suggest that "the holder is configured to receive both the cutting portion and the storage portion" as required by claims 1 and 26.

Apparently recognizing this deficiency in Paternuosto, the Office Action then states that "if [Paternuosto] is not deemed to disclose this limitation, the examiner turns to Jaeger." See page 3 of the Office Action. The Examiner relies on Jaeger for an

alleged teaching of a removable cutting edge. See page 3 of the Office Action. The Office Action further relies on Dowd for the alleged teaching of a protrusion on the cutting edge, acknowledging that neither Paternuosto nor Jaeger discloses “the use of [a] protrusion on the cutting edge that engages with the holder.” See page 4 of the Office Action. The Office Action asserts that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Paternuosto in view of Jaeger with the groove/protrusion taught by Dowd in order to provide a secure attaching mechanism between the blade and the holder.” See page 4 of the Office Action. Applicants respectfully disagree.

Dowd discloses a cutter bar 20 that includes a blade 22 having an enlargement 23 with a cutting edge 23'. See Col. 2, lines 103-105 of Dowd. Dowd further discloses a crusher bar 23, disposed parallel to cutter bar 20, that includes an enlargement 24 having laterally protruding lugs 26. See Col. 3 lines 2 and 3 of Dowd. Edges of enlargement 23 and lugs 26 are received by lateral grooves 18 and 19 in head 12. See Col. 2 lines 105-107 and Col. 3 lines 1-4 of Dowd. Applicants are unclear how the device of Paternuosto in view of Jaeger may be modified with the lugs 26 of enlargement 24 or edges of enlargement 23, as taught in Dowd, so that those laterally protruding portions would be received by the alleged groove of Paternuosto. The Office Action provides no guidance in this regard. The very position of the alleged groove of Paternuosto appears unable to accept any lateral protrusion of front rim 12. Furthermore, even if the protrusion were directed at the alleged groove, the protrusion would interfere with the attaching mechanism, i.e., spring ring 32, between storage container 22 and half-shell 10b. Substantial modification of the Paternuosto device,

including at least removal of ring 32 that provides the second engagement, would be necessary. Therefore, one skilled in the art would not be motivated to make such a modification.

For at least these reasons, Applicants request reconsideration and withdrawal of the Section 103(a) rejection of independent claims 1 and 26. Furthermore, claims 36-39, 41, and 44-49, depend from one of independent claims 1 and 26 and are allowable for at least the same reasons that independent claims 1 and 26 are allowable.

On page 4 of the Office Action, claims 6-11, 13, 14, 18, 19, 31-35, 42, and 43 were rejected under 35 U.S.C § 103(a) as being obvious over Paternuosto, Jaeger, and Dowd. Applicants traverse this rejection. As set forth above, no combination of Paternuosto, Jaeger, and Dowd discloses or suggests the combination of elements in each of independent claims 1 and 26. Claims 6-11, 13, 14, 18, 19, 31-35, 42, and 43 depend either directly or indirectly from one of independent claims 1 and 26, and are therefore allowable for at least the same reasons that their respective independent claims are allowable.

On page 5 of the Office Action, claims 16, 40, 50, 52-65, and 87-94 were rejected under 35 U.S.C § 103(a) as being obvious over Paternuosto in view of Jaeger, Dowd, and in further view of U.S. Patent No. 5,707,392 to Kortenbach ("Kortenbach"). Applicants respectfully traverse this rejection.

No combination of Paternuosto, Jaeger, Dowd, and Kortenbach discloses or suggests the claimed invention. For example, independent claim 50 recites an endoscopic instrument comprising, among other things, "a holder configured to receive the second end effector, wherein the second end effector has a non-straight portion

connecting a tang to a cutting edge and configured to be received in a correspondingly-shaped gap in the holder.” No combination of Paternuosto, Jaeger, Dowd, and Kortenbach discloses or suggests at least this aspect of independent claim 50 either alone or in combination with other aspects of independent claim 50.

Page 5 of the Office Action acknowledges that Paternuosto and Jaeger do not disclose “a second end effector (blade) having a non-straight tang” connected to a cutting portion. See page 5 of the Office Action. The Office Action, however, relies on Kortenbach for the alleged teaching of a “tang (58) connected to cutting edge (56) that is configured to be received with the holder (40).” See page 5 of the Office Action. Even assuming that the lobe 58 has a curved portion that corresponds to the claimed “non-straight portion” and that axle 40 corresponds to the claimed “holder,” which Applicants do not necessarily concede, axle 40 does not have a “correspondingly-shaped gap” to receive lobe 58. See Figs. 10, 11, and 12 of Kortenbach. Instead, quite the opposite, as lobe 58 has an axle mounting hole 68 that receives axle 40. Accordingly, the combination of Paternuosto, Jaeger, Dowd and Kortenbach fail to disclose at least the claimed combination including “a holder configured to receive the second end effector, wherein the second end effector has a non-straight portion connecting a tang to a cutting edge and configured to be received in a correspondingly-shaped gap in the holder,” as required by independent claim 50.

Though independent claim 91 was rejected under Section 103(a) as being obvious over Paternuosto in view of Jaeger, Dowd, and Kortenbach, the Examiner did not address the claim. Indeed, in explaining the rejection on page 5, the Examiner points to: (1) the subject matter of independent claim 50; and (2) the subject matter of

Kortenbach relating to a non-straight tang. The scope of independent claim 91, however, differs from that of independent claim 50 and does not include a "non-straight tang." Applicants therefore are unclear if the Examiner intended to reject independent claim 91 over the combination of Paternuosto, Jaeger, Dowd, and Kortenbach.

Further, no combination of Paternuosto, Jaeger, Dowd, and Kortenbach discloses or suggests independent claim 91. Independent claim 91 recites an end effector assembly for obtaining multiple tissue samples comprising, among other things, "wherein the holder is configured to receive the cutting portion and the storage portion, wherein a protrusion or a recess on the cutting portion is configured to mate with a recess or a protrusion on the storage portion." No combination of Paternuosto, Jaeger, Dowd, and Kortenbach discloses or suggests at least this aspect of independent claim 91 either alone or in combination with other aspects of independent claim 91. Indeed, these recitations are not addressed at all in the Office Action.

Though, page 4 of the Office Action asserts that "[t]he holder portion [in Paternuosto] has a groove shown in fig. 9 for receiving a lip on the storage portion," Fig. 9 of Paternuosto does not disclose that the front rim 12 mates with the storage portion lip. Neither Jaeger, Dowd, nor Kortenbach cure the deficiency of Paternuosto in such a way such that their combination would have rendered the present invention obvious. For at least this reason, the combination of Paternuosto, Jaeger, Dowd, and Kortenbach fails to render the subject matter of independent claim 91 unpatentable. Should the Examiner persist in the rejection, Applicants requests that the Examiner specifically address independent claim 91.

Accordingly, Applicants request the reconsideration and withdrawal of the Section 103(a) rejection of independent claims 50 and 91. Furthermore, dependent claims 16, 40, 52-65, 87-90, and 92-94 depend from one of independent claims 1, 50, and 91, and are therefore allowable for at least the same reasons as independent claims 1, 50, and 91.

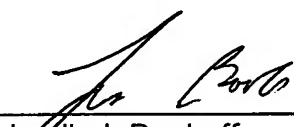
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 16, 2008

By: 

Leslie I. Bookoff
Reg. No. 38,084
(202) 408-4000